

ESTTA Tracking number: **ESTTA308718**

Filing date: **09/29/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Pirelli Tyre S.p.A.
Granted to Date of previous extension	09/30/2009
Address	Viale Sarca 222 Milan, 20126 ITALY

Attorney information	Virginia L. Carron Finnegan 901 New York Avenue NW Washington, DC 20001-4413 UNITED STATES virginia.carron@finnegan.com Phone:404-653-6452
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Applicant Information

Application No	77616233	Publication date	06/02/2009
Opposition Filing Date	09/29/2009	Opposition Period Ends	09/30/2009
Applicant	Zero Motorcycles, Inc. One Victor Square Scotts Valley, CA 95066 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Electric motorcycles; Motorcycles and structural parts therefor; Motorcycles for motocross

Applicant Information

Application No	77665628	Publication date	06/02/2009
Opposition Filing Date	09/29/2009	Opposition Period Ends	
Applicant	Zero Motorcycles, Inc. One Victor Square Scotts Valley, CA 95066 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Electric motorcycles; Motorcycles and
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structural parts therefor

Applicant Information

Application No	77665629	Publication date	06/02/2009
Opposition Filing Date	09/29/2009	Opposition Period Ends	
Applicant	Zero Motorcycles, Inc. One Victor Square Scotts Valley, CA 95066 UNITED STATES		


Goods/Services Affected by Opposition

Class 012. First Use: 2008/08/08 First Use In Commerce: 2008/08/08 All goods and services in the class are opposed, namely: Electric motorcycles; Motorcycles and structural parts therefor
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Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2749340	Application Date	06/01/2001
Registration Date	08/12/2003	Foreign Priority Date	01/03/2001
Word Mark	ZERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefor		

U.S. Registration No.	1625883	Application Date	12/01/1989
Registration Date	12/04/1990	Foreign Priority Date	NONE
Word Mark	PZERO		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 012. First use: First Use: 1988/09/09 First Use In Commerce: 1988/09/09 VEHICLE TIRES		
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U.S. Registration No.	2847159	Application Date	05/30/2001
Registration Date	06/01/2004	Foreign Priority Date	03/01/2001
Word Mark	ZERO NERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefore		

U.S. Registration No.	2783614	Application Date	05/31/2001
Registration Date	11/18/2003	Foreign Priority Date	01/03/2001
Word Mark	ZERO GIALLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefore		

U.S. Registration No.	3038910	Application Date	06/10/2003
Registration Date	01/10/2006	Foreign Priority Date	05/22/2003
Word Mark	SOTTOZERO		

Design Mark	SOTTOZERO
Description of Mark	NONE
Goods/Services	Class 012. First use: Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims and structural and replacement parts for all the aforesaid goods

U.S. Registration No.	2337503	Application Date	07/27/1998
Registration Date	04/04/2000	Foreign Priority Date	04/06/1998
Word Mark	P ZERO ROSSO		
Design Mark	P ZERO ROSSO		
Description of Mark	NONE		
Goods/Services	Class 012. First use: Tires, pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for land vehicles and parts therefore, namely, inner tubes and rims Class 035. First use: PLACING ADVERTISEMENTS FOR OTHERS; COMMERCIAL ADMINISTRATION, NAMELY, MANAGEMENT AND ADMINISTRATION OF TIRE AND CARE MAINTENANCE BUSINESSES; OFFICE WORK, NAMELY, PROVIDING ADMINISTRATIVE AND CLERICAL ASSISTANCE IN RELATION TO TIRE AND CARE MAINTENANCE BUSINESSES Class 037. First use: REPAIRING, INSTALLING, RETREADING, ROTATING AND BALANCING, AND CHANGING OF VEHICLE TIRES; CAR ASSISTANCE SERVICES, NAMELY, CHANGING WHEELS AND TIRES DURING CAR RACES		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	P ZERO		
Goods/Services	tires, pneumatic, semi-pneumatic and solid tires for vehicle wheels, wheels for vehicles, inner tubes, rims, strutral and replacement parts		

	therefore, boats, clothing, watches, shoes, glasses and sun glasses
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Attachments	76265012#TMSN.gif (1 page)(bytes) 76263956#TMSN.gif (1 page)(bytes) 76264188#TMSN.gif (1 page)(bytes) 76521615#TMSN.gif (1 page)(bytes) 75526377#TMSN.gif (1 page)(bytes) Notice of Opposition of ZERO X ZERO S and ZERO SS confusion.pdf (15 pages)(136079 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Virginia L. Carron/
Name	Virginia L. Carron
Date	09/29/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>PIRELLI TYRE S.P.A.</p> <p>Opposer</p> <p>v.</p> <p>ZERO MOTORCYCLES, INC.,</p> <p>Applicant.</p>	<p>Consolidated Opposition No.</p> <p>Serial No. 77/616233 Mark: ZERO X Filed: November 17, 2008 Published: June 2, 2009</p> <p>Serial No. 77/665628 Mark: ZERO SS Filed: February 6, 2009 Published: June 2, 2009</p> <p>Serial No. 77/665629 Mark: ZERO S Filed: February 6, 2009 Published: June 2, 2009</p>
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NOTICE OF OPPOSITION

Pirelli Tyre S.p.A., a società per azioni of Italy, having a place of business at Viale Sarca 222, I-20136 Milan, Italy, ("Opposer"), believes that it is being and will be damaged by the registration of the marks ZERO X, ZERO SS and ZERO S as shown in Application Serial Numbers 77/616233, 77/665628 and 77/665629, and therefore, opposes the same. As grounds for opposition, Opposer alleges that, upon actual knowledge with respect to Opposer's own acts, and upon information and belief as to other matters:

Opposer and its ZERO and ZERO-Formative Marks

1. Opposer Pirelli Tyre S.p.A. is a società per azioni of Italy, having a place of business at Viale Sarca 222, I-20136 Milan, Italy.
2. Opposer Pirelli Tyre S.p.A. is a wholly-owned subsidiary of Pirelli & C. S.p.A., which is a società per azioni of Italy, having a business address at Via Gaetano Negri 10, I-20123 Milan, Italy.
3. Opposer and its parent company, Pirelli & C. S.p.A., through their predecessors-in-interest, related companies, and licensees, have been engaged in the manufacture, advertising, and sale of a wide variety of products, including tires and wheels and related parts, boats, clothing, watches, shoes, glasses, sun glasses and other products since long prior to the filing date of the application, and any date of first use alleged by Applicant.
4. Opposer, through its predecessors-in-interest, parent company and related companies, have used ZERO and their ZERO formative marks in the United States since at least 1988.
5. Opposer Pirelli Tyre S.p.A. is the owner of, among others, the following valid and subsisting United States trademark registrations for the mark ZERO and ZERO-formative marks (copies of the certificates of registration are attached as Exhibit A):

Mark	Reg. No. Reg. Date	Goods
ZERO	2749340 08/12/03	Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefor
PZERO	1625883 12/04/90	Vehicle tires
ZERO NERO	2847159 06/01/04	Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefore
ZERO GIALLO	2783614 11/18/03	Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefore
SOTTOZERO	3038910 01/10/06	Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts for all the aforesaid goods
P ZERO ROSSO	2337503 04/04/00	Tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for land vehicles and parts therefore, namely, inner tubes and rims

6. The foregoing registrations are valid and subsisting and constitute *prima facie* evidence of the validity of the marks and registrations, and of Opposer's ownership of and exclusive right to use the marks in commerce, and provide constructive notice of ownership thereof by Opposer.

7. Opposer, along with its parent company, Pirelli & C. S.p.A., are the owners of common law trademark rights for the ZERO and ZERO-formative marks, including, but not limited to P ZERO, for a wide variety of products including, without limitation, tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels, wheels for vehicles, inner tubes, rims, structural and replacement parts therefore, boats, clothing, watches, shoes, glasses, and sun glasses.

8. As a result of Opposer's, and its parent's, promotional efforts and commercial success, Opposer's ZERO and ZERO-formative marks have achieved such widespread public recognition that they became famous well prior to both the filing date of the Applicant's applications, and the dates of first use alleged by Applicant in each of the opposed applications.

Applicant and its ZERO-Formative Applications

9. Zero Motorcycles, Inc. ("Applicant") is a corporation of the state of Delaware having an address of One Victor Square, Scotts Valley, California 95066.

10. Applicant filed Application Serial No. 77/616233 on November 17, 2008, for the mark ZERO X for "Electric motorcycles; Motorcycles and structural parts therefor; Motorcycles for motocross" in International Class 12, under Section 1(b) of the Trademark Act, claiming an intention to use the mark.

11. Applicant has not yet submitted an allegation of use of the mark ZERO X in Application Serial No. 77/616233.

12. Applicant filed Application Serial No. 77/665628 on February 6, 2009, for the mark ZERO SS for "Electric motorcycles; Motorcycles and structural parts therefor" in International Class 12, under Section 1(b) of the Trademark Act, claiming an intention to use the mark.

13. Applicant has not yet submitted an allegation of use of the mark ZERO SS in Application Serial No. 77/665628.

14. Applicant filed Application Serial No. 77/665629 on February 6, 2009, for the mark ZERO S for “Electric motorcycles; Motorcycles and structural parts therefor” in International Class 12, under Section 1(a) of the Trademark Act, claiming a date of first use in commerce of August 8, 2008.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

15. Opposer repeats and realleges each and every allegation set forth in Paragraphs 1 through 14.

16. Opposer, and its parent company, have priority based on their prior common law rights and their prior valid and subsisting registrations for marks comprised of or containing ZERO set forth in Paragraphs 5 and 7 above. Since well prior to the filing date of the Applicant’s applications, Opposer and its parent company and their predecessors-in-interest and licensees have used, advertised, sold, and transported in commerce, *inter alia*, tires, wheels and related parts, and other goods, including those set forth above in paragraphs 5 and 7, under the ZERO and ZERO formative marks.

17. Opposer’s ZERO mark is encompassed in its entirety within each of the marks of Applicant’s ZERO-formative applications. Applicant’s ZERO-formative marks are very similar in sound, pronunciation, and appearance to Opposer’s ZERO and ZERO-formative marks.

18. The products identified in Applicant’s applications are closely related to the products offered and sold by Opposer and its parent company in connection with their ZERO and ZERO-formative marks, and to the products covered by Opposer’s

trademark registrations. Applicant's goods are motorcycles and parts therefor and Opposer's goods are tires and wheels for vehicles, including motorcycles, parts for tires and wheels for vehicles. As such, the goods of the parties marks are closely related.

19. In view of the similarity' of the parties' marks and the identical and/or closely related nature of the parties' goods, Applicant's ZERO-formative marks so resemble Opposer's previously used ZERO and ZERO-formative marks, and previously registered ZERO marks, as to be likely to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d), 15 U.S.C. § 1052(d).

20. WHEREFORE, Opposer has been and will continue to be damaged by the marks ZERO X, ZERO SS and ZERO S as shown in Application Serial Numbers 77/616233, 77/665628 and 77/665629 and will be damaged further if the subject applications mature into registrations, and therefore request that this opposition be sustained and that registration of the marks ZERO X, ZERO SS and ZERO S as shown in Application Serial Numbers 77/616233, 77/665628 and 77/665629 be denied.

A filing fee has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 06-0916.

Respectfully submitted,

PIRELLI TYRE S.P.A.

Dated: September 29, 2009

By: /s/Virginia L. Carron
Virginia L. Carron

Notice of Opposition
Serial Nos. 77/616233, 77/665628 and 77/665629
Marks: ZERO X, ZERO SS and ZERO S

Laurence R. Hefter
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
(404) 653-6452

Attorneys for Opposer

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by first class mail or airmail, postage prepaid, on this 29th day of September 2009, upon Applicant and counsel for Applicant at the following addresses:

ZERO MOTORCYCLES, INC.
ONE VICTOR SQUARE
SCOTTS VALLEY, CA 95066

MIKE RODENBAUGH
RODENBAUGH LAW
PO BOX 7775 #55819
SAN FRANCISCO, CA 94120-7775

/s/Virginia L. Carron

Notice of Opposition
Pirelli Tyre S.p.A.
Serial Nos. 77/616233, 77/665628 and 77/665629
Marks: ZERO X, ZERO SS and ZERO S

Exhibit A

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

United States Patent and Trademark Office

Reg. No. 2,749,340

Registered Aug. 12, 2003

**TRADEMARK
PRINCIPAL REGISTER**

ZERO

PIRELLI PNEUMATICI S.P.A. (ITALY CORPORATION)
VIALE SARCA 222
20126 MILANO, ITALY

PRIORITY CLAIMED UNDER SEC. 44(D) ON
ITALY APPLICATION NO. MI2001C00232, FILED 1-
3-2001, REG. NO. 846589, DATED 5-28-2001, EXPIRES
1-3-2011.

FOR: TIRES; PNEUMATIC, SEMI-PNEUMATIC
AND SOLID TIRES FOR VEHICLE WHEELS;
WHEELS FOR VEHICLES, INNER TUBES, RIMS,
STRUCTURAL AND REPLACEMENT PARTS
THEREFOR, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31,
35 AND 44).

SER. NO. 76-265,012, FILED 6-1-2001.

HELLEN BRYAN-JOHNSON, EXAMINING ATTOR-
NEY

Int. Cl.: 12

Prior U.S. Cl.: 35

United States Patent and Trademark Office

Reg. No. 1,625,883

Registered Dec. 4, 1990

**TRADEMARK
PRINCIPAL REGISTER**

PZERO

**PIRELLI ARMSTRONG TIRE CORPORATION
(DELAWARE CORPORATION)
500 SARGENT DRIVE
NEW HAVEN, CT 065360201**

**FIRST USE 9-9-1988; IN COMMERCE
9-9-1988.**

SER. NO. 74-006,960, FILED 12-1-1989.

**FOR: VEHICLE TIRES, IN CLASS 12 (U.S. CL.
35).**

STEPHEN JANOSKI, EXAMINING ATTORNEY

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

United States Patent and Trademark Office

Reg. No. 2,847,159

Registered June 1, 2004

**TRADEMARK
PRINCIPAL REGISTER**

ZERO NERO

PIRELLI PNEUMATICI S.P.A. (ITALY CORPORATION)
VIALE SARCA 222
20126 MILANO, ITALY

PRIORITY CLAIMED UNDER SEC. 44(D) ON
ITALY APPLICATION NO. MI2001C00232, FILED 3-
1-2001, REG. NO. 846590, DATED 5-28-2001, EXPIRES
3-1-2011.

FOR: TIRES; PNEUMATIC, SEMI-PNEUMATIC
AND SOLID TIRES FOR VEHICLE WHEELS;
WHEELS FOR VEHICLES, INNER TUBES, RIMS,
STRUCTURAL AND REPLACEMENT PARTS
THEREFORE, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31,
35 AND 44).

SER. NO. 76-263,956, FILED 5-30-2001.

WON TEAK OH, EXAMINING ATTORNEY

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

United States Patent and Trademark Office

Reg. No. 2,783,614

Registered Nov. 18, 2003

**TRADEMARK
PRINCIPAL REGISTER**

ZERO GIALLO

PIRELLI PNEUMATICI S.P.A. (ITALY CORPORATION)
VIALE SARCA 222
20126 MILANO, ITALY

PRIORITY CLAIMED UNDER SEC. 44(D) ON
ITALY APPLICATION NO. M12001C00232, FILED 1-
3-2001, REG. NO. 846591, DATED 5-28-2001, EXPIRES
1-3-2011.

FOR: TIRES; PNEUMATIC, SEMI-PNEUMATIC
AND SOLID TIRES FOR VEHICLE WHEELS;
WHEELS FOR VEHICLES, INNER TUBES, RIMS,
STRUCTURAL AND REPLACEMENT PARTS
THEREFORE, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31,
35 AND 44).

SER. NO. 76-264,188, FILED 5-31-2001.

HELLEN BRYAN-JOHNSON, EXAMINING ATTOR-
NEY

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

United States Patent and Trademark Office

Reg. No. 3,038,910

Registered Jan. 10, 2006

**TRADEMARK
PRINCIPAL REGISTER**

SOTTOZERO

PIRELLI PNEUMATICI S.P.A. (ITALY CORPORATION)
VIALE SARCA 222
20126 MILAN
ITALY

FOR: TIRES; PNEUMATIC, SEMI-PNEUMATIC AND SOLID TIRES FOR VEHICLE WHEELS; WHEELS FOR VEHICLES, INNER TUBES, RIMS AND STRUCTURAL AND REPLACEMENT PARTS FOR ALL THE AFORESAID GOODS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

PRIORITY CLAIMED UNDER SEC. 44(D) ON ITALY APPLICATION NO. M12003C00522, FILED 5-22-2003, REG. NO. 899275, DATED 5-22-2003, EXPIRES 5-22-2013.

THE ENGLISH TRANSLATION OF THE WORD SOTTOZERO IS "SUB ZERO" OR "BELOW ZERO".

SER. NO. 76-521,615, FILED 6-10-2003.

JENNIFER CHICOSKI, EXAMINING ATTORNEY

Int. Cls.: 12, 35 and 37

Prior U.S. Cls.: 19, 21, 23, 31, 35, 44, 100, 101,
102, 103 and 106

United States Patent and Trademark Office

Corrected

Reg. No. 2,337,503

Registered Apr. 4, 2000

OG Date Jan. 9, 2001

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

P ZERO ROSSO

PIRELLI PNEUMATICI SPA. (ITALY COR-
PORATION)
VIALE SARCA 222
20126 MILANO, ITALY, BY CHANGE OF
NAME

PRIORITY CLAIMED UNDER SEC. 44(D)
ON ITALY APPLICATION NO. MI98C003448,
FILED 4-6-1998, REG. NO. 00750866, DATED
5-26-1998, EXPIRES 4-6-2008.

OWNER OF U.S. REG. NO. 1,625,883.

"ROSSO" IN ITALIAN MEANS "RED"

FOR: TIRES, PNEUMATIC, SEMI-PNEU-
MATIC AND SOLID TIRES FOR VEHICLE
WHEELS; WHEELS FOR LAND VEHICLES
AND PARTS THEREFORE, NAMELY, INNER-
TUBES AND RIMS, IN CLASS 12 (U.S. CLS.
19, 21, 23, 31, 35 AND 44).

FIRST USE IN COMMERCE.

FOR: PLACING ADVERTISEMENTS FOR
OTHERS; COMMERCIAL ADMINISTRATION,

NAMELY, MANAGEMENT AND ADMINIS-
TRATION OF TIRE AND CARE MAINTE-
NANCE BUSINESSES; OFFICE WORK,
NAMELY, PROVIDING ADMINISTRATIVE
AND CLERICAL ASSISTANCE IN RELATION
TO TIRE AND CARE MAINTENANCE BUSI-
NESSES, IN CLASS 35 (U.S. CLS. 100, 101
AND 102).

FIRST USE; IN COMMERCE.

FOR: REPAIRING, INSTALLING, RE-
TREADING, ROTATING AND BALANCING,
AND CHANGING OF VEHICLE TIRES; CAR
ASSISTANCE SERVICES, NAMELY, CHANG-
ING WHEELS AND TIRES DURING CAR
RACES, IN CLASS 37 (U.S. CLS. 100, 103
AND 106).

FIRST USE; IN COMMERCE.

SER. NO. 75-526,377, FILED 7-27-1998.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Jan. 9, 2001.*

COMMISSIONER OF PATENTS AND TRADEMARKS